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Jamaica, NY 11436

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DEC 0 6 2005

OFFICE OF PETITIONS

In re Application of :
Temeca Taylor :
Application No. 09/706,586 :
Filed: August 6, 2001 : ON PETITION
Title of Invention: :
DIGITAL AUDIO MANIPULATOR :

This is a decision on the correspondence filed November 18, 2005, requesting Reconsideration of a Petition for Revival of an Application Abandoned Unavoidably Under 37 CFR 1.137(a).

The petition is **dismissed.**

Any further petition to revive the above-identified application (under 37 CFR 1.137(a)), must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under 37 CFR 1.137". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed October 1, 2004. The Notice set a three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No response having been received, the application became abandoned on January 2, 2005. A Notice of Abandonment was mailed on April 8, 2005.

Applicant's October 28, 2005 Response

In response to the Notice, Applicant filed a petition on October 28, 2005 and asserted that she filed a Change of Address Form; however, this Office incorrectly entered the address appearing in the Change of Address Form. As a result, Applicant argued

that the Office action was mailed to an incorrect correspondence address. In support of this assertion, Applicant filed a copy of a Change of Correspondence form with the October 28, 2005 petition, executed on October 28, 2005.

The petition was dismissed in a Decision mailed November 8, 2005. The Decision dismissing the petition informed Applicant that there are two methods wher[e]by Applicant may demonstrate that correspondence was filed in this Office. The first method, under 37 CFR 1.8, provides for the filing of papers and fees using a "Certificate of Mailing." The second method, in accordance with the Manual of Patent Examining Procedure "MPEP" § 503 provides that Applicant may provide a stamped, self-addressed return-receipt postcard itemizing the papers filed with the postcard. This Office will stamp the postcard and deposit it in the mail. "A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all items listed thereon on the date stamped thereon by the USPTO." MPEP 503.

Applicant did not provided any evidence that would demonstrate that the Change of Address Form was filed in this Office prior to October 28, 2005. The petition was dismissed without prejudice. Applicant was advised that if she has documentary evidence, e.g. a copy of the Change of Address that was putatively filed (that included a proper Certificate of Mailing), or a copy of a return receipt postcard, to support her assertion that a Change of Address Form was filed in this Office prior to October 28, 2005, Applicant should submit such evidence in any renewed petition.

The instant request for reconsideration

Applicant files the instant Request for Reconsideration and again asserts that this Office mistakenly entered her new correspondence address information.

A Grantable Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (**1**) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance,

or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (**2**) the petition fee as set forth in 37 CFR 1.17(l); (**3**) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (**4**) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks items (**1**) and (**3**) as set forth above.

As to item (**1**), Applicant has not filed a reply to the Office action. A copy of the Office action is attached.

As to item (**3**), Applicant is again advised that nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.[1] The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Further to this, an allegation that an Office action was not received must be adequately supported, in order for the petition to be granted and a new Office action (and period for reply) mailed[2].

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[1] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

[2] The inclusion of a copy of he non-final Office action with this decision is not an indication that the petition is granted. It is intended to facilitate the filing of a reply with a petition to revive under 37 CFR 1.137(b).

It is again iterated that decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of

whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."[3]

Again, a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c).

Analysis and Conclusion

As to item (**3**), Applicant has not provided an adequate showing of unavoidable delay. If Applicant has documentary evidence, e.g. a copy of the Change of Address that was putatively filed, or a copy of a return receipt postcard, to support her assertion that a Change of Address Form was filed in this Office prior to October 28, 2005, Applicant should submit such evidence in any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

Attachment: October 1, 2004 Office action

[3] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).